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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/657,039	09/07/2000	Christopher Lee Tobey	JP920000169US1	1586
30449	7590	11/30/2004	EXAMINER	
SCHMEISER, OLSEN + WATTS SUITE 201 3 LEAR JET LATHAM, NY 12033			BLECK, CAROLYN M	
		ART UNIT	PAPER NUMBER	
		3626		

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/657,039

Applicant(s)

TOBEY, CHRISTOPHER LEE

Examiner

Carolyn M Bleck

Art Unit

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*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 01 September 2004.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1,3,4,7-10,13,15,16,18,20-22 and 24-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3,4,7-10,13,15,16,18,20-22 and 24-41 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

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**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the amendment filed 1 September 2004. Claims 1, 3-4, 7-10, 13, 15-16, 18, 20-22, 24-41 are pending. Claims 2, 5-6, 11-12, 14, 17, 19, and 23 have been cancelled. Claims 1, 4, 8, 10, 13, 18, and 24 have been amended. Claims 26-41 are newly added.

***Claim Rejections - 35 USC § 101***

2. The rejections of claims 1-12 are hereby withdrawn due to the amendment filed 1 September 2004.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 7, 13, 24, 26-27, 34-35, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sims et al. (5,434,775) in view of Bates (6,057,779), for substantially the same reasons as given in the previous Office Action (paper number 8), and further in view of Maynard (5,949,335) and Bridges, Jr. et al. (4,141,078).
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(A) Claims 1, 26-27, 34-35, and 38-39 has been amended to recite "assets being moveable between a plurality of sites only by being routed through said central site and not being moveable directly from a first site to a second site of the plurality of sites" and "each asset of said assets being independently selected from the group consisting of a computer hardware asset and a computer software asset."

Sims and Bates do not expressly disclose the asset being a computer hardware asset and a computer software asset. Maynard discloses the asset being processors, work stations, monitors, printers, scanners and network servers, and software (col. 1 lines 50-67).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Maynard within the method of Sims and Bates with the motivation of preventing theft throughout the supply chain (Maynard; col. 1 lines 18-22)

Sims and Bates do not expressly disclose "assets being moveable between a plurality of sites only by being routed through said central site and not being moveable directly from a first site to a second site of the plurality of sites". Bridges discloses a centralized computer system for checking out an item, where the item must be returned to central location before being checked out again (Bridges; col. 1 line 40 to col. 2 line 45, col. 4 lines 15-60).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Bridges within the method of Sims

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and Bates with the motivation of maximizing control and accuracy over items (col. 3 lines 29-40).

(B) As per claim 7, Sims discloses determining the condition of each of device identified by each tag on the device based on detecting the device, wherein the conditions include ready for use, in need of cleaning, and in need of repair (col. 9 line 35 to col. 10 line 41, col. 22 line 39 to col. 23 line 6).

While Sims and Bates do not expressly disclose "determining whether an asset should be retained, and thus stored for further use, or withdrawn from use", it is respectfully submitted that that Sims disclosure of determining whether a device is in need of repair includes determining whether a device should be retained (i.e., can be fixed) or whether a device should be withdrawn (i.e., cannot be fixed). Thus, at the time the invention was made it would have been obvious to one skilled in the art to modifying the method taught by Sims and Bates collectively to include determining whether an asset should be retained, and thus stored for further use, or withdrawn from use with the motivation of ensuring the devices are in proper condition for use (Sims; col. 1 lines 10-21).

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(C) System claim 13 repeat the subject matter of method claim 1, respectively, as a set of apparatus elements rather than as a series of steps. As the underlying processes of claim 1 have been shown to be fully disclosed by the collective teachings of Sims, Bates, Maynard, and Bridges in the above rejections of claim 1, it is readily apparent

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that the system disclosed collectively by Sims, Bates, Maynard, and Bridges includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

(D) Claim 24 repeats the subject matter of method claim 1, respectively, as a series of computer program product carried on a storage medium rather than as a series of steps. As the underlying processes of claim 1 have been shown to be fully disclosed by the collective teachings of Sims, Bates, Maynard, and Bridges in the above rejection of claim 1, it is readily apparent that the system disclosed collectively by Sims, Bates, Maynard, and Bridges includes a computer program product to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

5. Claims 3-4, 15-16, 25, 28-29, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sims et al. (5,434,775), Bates (6,057,779), Maynard (5,949,335), and Bridges, Jr. et al. (4,141,078) as applied to claim 1 above, and further in view of Guthrie et al. (5,289,372).

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(A) As per claims 3 and 25, the relevant teachings of Sims and Bates, and the motivation for their combination is as discussed in the rejections above, and incorporated herein.

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Sims, Bates, Maynard, and Bridges fail to expressly disclose for each asset, recording configuration information relevant to that asset on said database and on each configuration of a said asset at said central site, updating said configuration information on said database. However, Sims discloses determining the condition of each of device identified by each tag on the device based on detecting the device, wherein the conditions include ready for use, in need of cleaning, and in need of repair, and performing said cleaning and repair in a storeroom area or materials management area (reads on "at central site") (col. 5 lines 10-28, col. 9 line 35 to col. 10 line 41, col. 15 lines 40-55, col. 22 line 39 to col. 23 line 6).

Guthrie discloses an automated system for storing configuration information for a plurality of pieces of equipment, wherein the automated system instantaneously detects both authorized and unauthorized changes to a physical hardware configuration of a piece of equipment and automatically communicates configuration change information to a centralized database which correlates the changes (Abstract; Fig. 1-2, col. 4 lines 39-55, col. 22 lines 37-43).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Guthrie within the method taught collectively by Sims, Bates, Maynard, and Bridges with the motivation of efficiently and effectively managing configuration changes which is crucial to providing effective and efficient engineering, installation, and maintenance services by having access to current and accurate configuration information (Guthrie; col. 1 lines 10-27, col. 2 lines 15-25).

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(B) As per claim 4 and 41, the Examiner respectfully submits that while the applied prior art does not explicitly disclose an IP address, it is well known in the art to use IP addresses to identify devices. The motivation being to properly locate hardware on a network.

(C) Claim 15 repeats the same limitations as claim 3, and is therefore rejected for the same reasons given for claim 3, and incorporated herein.

(D) As per claim 16, Guthrie discloses storing hardware configuration information for a piece of equipment (Abstract; Fig. 1-2, col. 4 lines 39-55, col. 22 lines 37-43).

(E) As per claims 28-29, the Examiner respectfully submits that notifying a user of a delivery via fax or other form of communication is well known in the art. For example, a user who orders a computer is notified in advance via email or fax that the delivery is arriving. In addition, installing and testing a computer upon delivery is also well known in the art. For example, the IT staff typically is required to test any hardware being added to a corporate network. The motivation being to ensure the products work correctly.

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(F) As per claim 41, Maynard discloses storing asset information about software (col. 1 lines 50-67).

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6. Claims 8-10, 20-22, 30-33, and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sims et al. (5,434,775) in view of Bates (6,057,779) and Guthrie et al. (5,289,372), for substantially the same reasons as given in the previous Office Action (paper number 8), and further in view of Maynard (5,949,335) and Bridges, Jr. et al. (4,141,078).

(A) As per claims 8-9, 10, and 30-31, Sims discloses a method for tracking the locations of a plurality of devices using a network of communication links comprising (Abstract):

- (a) initially storing a new device at a materials management area (col. 15 lines 40-55) (reads on "receiving a new asset at a central site");
  - (b) entering information about the new device (e.g., name, manufacturer, serial number, property number, etc.) through a computer interface and providing each of said new devices with a tag that identifies said device with respect to other said devices, wherein the tag comprises a tag address to identify the particular device (Fig. 8-9, col. 5 line 55 to col. 6 line 23, col. 15 lines 40-55, col. 22 lines 45-50, col. 23 lines 4-12) (reads on "assigning a unique identifier to each said asset");
  - (c) storing information that relates each one of the plurality of devices to a determined location with respect to the communication links, such as those associated with materials management area and data management computer, in a database (Fig. 1, col. 22 lines 38-44, col. 24 lines 12-15) (reads on "recording the location of said asset with respect to said central site in a database");
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(d) when moving a device, detecting an event such as a disconnection of a tag from a link and reporting and entering the event, i.e., the removal of the device from the communication link in it's current location, into the database (Fig. 7-10, col. 9 line 35 to col. 10 line 53) (reads on "on movement of a said asset, recording exit of the asset from the current location"); and

(e) detecting an event such as a connection of a tag to a link and reporting and entering the event, i.e., the addition of the device to the communication link in it's current location, into the database (Fig. 7-10, col. 9 line 35 to col. 10 line 53).

Sims fails to expressly disclose recording the intended destination site in said database and verifying entry of the asset at the destination site, being the new current location, in said database.

Bates discloses storing in memory a desired geographical location (reads on "recording the intended destination site") and comparing the stored geographical location to a respective determined geographical location to determine whether cargo (reads on "asset") falls within the desired geographical location, wherein the respective determined geographical location is stored in memory (Fig. 7-8, col. 1 lines 35-46, col. 1 line 65 to col. 2 line 7, col. 2 lines 19-40, col. 4 lines 3-63, col. 5 lines 43-55). The teachings of a database are disclosed by Sims, and are discussed above.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the features of Bates within the method of Sims with the motivation of reducing the risk of theft by preventing unauthorized access to cargo through a system of verifying the location of the cargo (Bates; col. 1 lines 14-32, col. 1

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liens 35-46) and in order to rapidly determine where devices are stored, as well as the number of devices that are available for use, to efficiently manage the inventory of devices (Sims; col. 1 lines 10-21).

Sims and Bates fail to expressly disclose for each asset, recording configuration information relevant to that asset on said database and upon each reconfiguration of an asset at the central site, said configuration information is updated in said database. However, Sims discloses determining the condition of each of device identified by each tag on the device based on detecting the device, wherein the conditions include ready for use, in need of cleaning, and in need of repair, and performing said cleaning and repair in a storeroom area or materials management area (reads on "at central site") (col. 5 lines 10-28, col. 9 line 35 to col. 10 line 41, col. 15 lines 40-55, col. 22 line 39 to col. 23 line 6).

Guthrie discloses an automated system for storing configuration information for a plurality of pieces of equipment, wherein the automated system instantaneously detects both authorized and unauthorized changes to a physical hardware configuration of a piece of equipment and automatically communicates configuration change information to a centralized database which correlates the changes (Abstract; Fig. 1-2, col. 4 lines 39-55, col. 22 lines 37-43).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Guthrie within the method taught collectively by Sims and Bates with the motivation of efficiently and effectively managing configuration changes which is crucial to providing effective and efficient engineering,

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installation, and maintenance services by having access to current and accurate configuration information (Guthrie; col. 1 lines 10-27, col. 2 lines 15-25).

Sims and Bates do not expressly disclose the asset being a computer hardware asset and a computer software asset. Maynard discloses the asset being processors, work stations, monitors, printers, scanners and network servers (col. 1 lines 50-67).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Maynard within the method of Sims and Bates with the motivation of preventing theft throughout the supply chain (Maynard; col. 1 lines 18-22)

Sims and Bates do not expressly disclose "assets being moveable between a plurality of sites only by being routed through said central site and not being moveable directly from a first site to a second site of the plurality of sites". Bridges discloses a centralized computer system for checking out an item, where the item must be returned to central location before being checked out again (Bridges; col. 1 line 40 to col. 2 line 45, col. 4 lines 15-60).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Bridges within the method of Sims and Bates with the motivation of maximizing control and accuracy over items (col. 3 lines 29-40).

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(B) System claim 18 repeats the subject matter of method claim 8, respectively, as a set-of-apparatus-elements-rather-than-as-a-series-of-steps.—As-the-underlying-processes

of claim 8 have been shown to be fully disclosed by the collective teachings of Sims, Bates, Maynard, Guthrie, and Bridges in the above rejections of claims 8, it is readily apparent that the system disclosed collectively by Sims, Bates, Maynard, Guthrie, and Bridges includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 8, and incorporated herein.

(C) As per claim 20, the relevant teachings of Sims and Bates, and the motivation for their combination is as discussed in the rejections above, and incorporated herein.

Sims, Bates, Maynard, and Bridges fail to expressly disclose for each asset, recording configuration information relevant to that asset on said database and on each configuration of a said asset at said central site, updating said configuration information on said database. However, Sims discloses determining the condition of each device identified by each tag on the device based on detecting the device, wherein the conditions include ready for use, in need of cleaning, and in need of repair, and performing said cleaning and repair in a storeroom area or materials management area (reads on “at central site”) (col. 5 lines 10-28, col. 9 line 35 to col. 10 line 41, col. 15 lines 40-55, col. 22 line 39 to col. 23 line 6).

Guthrie discloses an automated system for storing configuration information for a plurality of pieces of equipment, wherein the automated system instantaneously detects both authorized and unauthorized changes to a physical hardware configuration of a piece of equipment and automatically communicates configuration change information

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to a centralized database which correlates the changes (Abstract; Fig. 1-2, col. 4 lines 39-55, col. 22 lines 37-43).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Guthrie within the method taught collectively by Sims, Bates, Maynard, and Bridges with the motivation of efficiently and effectively managing configuration changes which is crucial to providing effective and efficient engineering, installation, and maintenance services by having access to current and accurate configuration information (Guthrie; col. 1 lines 10-27, col. 2 lines 15-25).

(D) As per claim 22, Guthrie discloses storing hardware configuration information for a piece of equipment (Abstract; Fig. 1-2, col. 4 lines 39-55, col. 22 lines 37-43).

(E) As per claims 32-33, the Examiner respectfully submits that notifying a user of a delivery via fax or other form of communication is well known in the art. For example, a user who orders a computer is notified in advance via email or fax that the delivery is arriving. In addition, installing and testing a computer upon delivery is also well known in the art. For example, the IT staff typically is required to test any hardware being added to a corporate network. The motivation being to ensure the products work correctly.

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(F) Claims 36 and 37 repeat the subject matter of claim 18, are therefore rejected for the same reasons given for claim 18, and incorporated herein.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches automatic library control apparatus (4,153,931), library check out/ check in system (5,288,980), and method and apparatus for classifying equipment in asset management database (6,650,346).
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10. **Any response to this action should be mailed to:**

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**Or faxed to:**

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

(703) 746-8374 [Informal/ Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7th Floor (Receptionist).

Alexander Kalinowski  
PRIMARY EXAMINER

CB

November 23, 2004